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09/688,441	10/16/2000	Bayard S. Webb	0112300/141	1896

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BELL, BOYD & LLOYD LLC  
P. O. BOX 1135  
CHICAGO, IL 60690-1135

EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/688,441

**Applicant(s)**

WEBB ET AL.

**Examiner**

Steven Ashburn

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-38 is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>07/19/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 19, 2004 has been entered.

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 13, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the claims describe a game having multiple rounds wherein (i) the determination of whether to assign an item to a symbol in one round is independent of other rounds and (ii) items are assigned to different numbers of symbols in each round. These limitations are contradictory because the assigning items to different numbers of symbols in each rounds requires that the determination be dependent on other rounds. Thus the claims are indefinite. For the purposes of examination, the examiner interprets the limitations to mean the assignment of item to symbols in each round is random and thereby independent and probably different in other rounds.

**Claim Rejections - 35 USC § 103**

**Claim 1, 2, 12, 13 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie, GB 2,144,644 A (Mar. 13, 1985) in view of Feola, U.S. Patent 6,149,156 (Nov. 21, 2000) and Kamille, U.S. Patent 5,855,514 (Jan. 5, 1999).**

Claims 1 and 13. Barrie discloses a gaming machine having player selections over multiple rounds that provides a dramatic narration during which a player makes choices, the outcome of which is governed by chance. *See abstract*. The player choice may result in dramatic scenes on a screen showing that the player has won a reward, has lost, or has his choice of a reward or an opportunity to make a further choice with the possibility of winning a higher reward. *See id*. The individual outcomes are determined with the aid of a random number generator. *See id*.

Barrie teaches the following features of the claims:

- a. Displaying a plurality of symbols on a display of the gaming device. *See fig. 3(42)*.
- b. A plurality of rounds. *See fig. 9, 9(a); p. 2:23-76*.
- c. Means for enabling a player to select one of the symbols in each of the rounds. *See p. 1:42-47*.
- d. A display device operable for displaying the plurality of symbols. *See fig. 1(14)*.
- e. A controller operable with the selection means and the display device to randomly assign an item to at least one, a plurality or all of the plurality of symbols, to enable to player to select one of the symbols in each of the rounds, and to provide an award to the player if thee player selects one of the symbols having an assigned item. *See fig. 2; p. 1:48-54, 2:6-22*.
- f. Selecting a prize and providing the prize to the player chooses a symbol having the assigned item. *See id*.

However, Barrie does not describe the following limitations:

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- a. Independent rounds. In Barrie, advancement to each round depends upon a successful outcome in a prior round.
- b. Determining whether to assign an item to all of the plurality of symbols. Barrie assigns at least one win and one lose outcome in each round.

Regardless, as shown below, it would have been obvious to an artisan to modify the gaming device described by Barrie to add these features.

Feola discloses an analogous selection game having multiple rounds. In contrast to Barrie, the rounds in Feola are independent. *See col. 1:56-67*. The reference states that there is no requirement that a player play an earlier round to play a later round. *See id.* As a result, the game made more exciting because a player can win in later rounds if he loses an earlier round. In view of Feola, it would have been obvious to an artisan at the time of the invention to modify the gaming device disclosed by Barrie, wherein a player participates in multiple rounds to add the feature of making the rounds independent. As taught by Feola, the modification would make the game more exciting for players because player can win in later rounds if he loses an earlier rounds.

Kamille discloses an analogous gaming device for playing a selection game. *See col. 3:59-4:3*. Similar to Barrie, game selections include either win or lose outcomes. *See col. 3:59-4:3*. However, in contrast to Barrie, Kamille discloses that game may selections may all be winning outcomes. *See col. 1:56-2:3*. In this way, the probability of winning is controlled which contributes the game's popularity. *See id.* In view of Kamille, it would have been obvious to an artisan to modify the gaming device disclosed by Barrie, wherein a player picks selections that are either winners or losers, to add the feature of assigning an item to all of the plurality of symbols. As suggested by Kamille, the modification would allow the operator to provide a game in which some outcomes are guaranteed winners and thereby increase its popularity. *See id.*

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Thus, when the prior art is taken as a whole by an artisan at the time of the invention it collectively suggests modifying Barrie to add the features of having independent rounds and determining whether to assign an item to all of the plurality of symbols in a round.

Claim 2: Barrie teaches having the controller assign an item to a plurality of symbols in each round. *See fig. 3-9, p. 1:55-69, 3:1-19.*

Claim 22: Barrie teaches revealing that a symbol has an assigned item when the player selects a symbol having the assigned item. *See id.*

Claim 23: The multi-round gaming device suggested by Barrie in view of Feola and Kamille describes all the features of the instant claims except revealing that all symbols having an assigned item indeed have an assigned item. Regardless of the deficiency, the feature was known in the art at the time of the invention and would have been obvious to an artisan. It is notoriously well known in the art to reveal unselected selections from a set of hidden selections to demonstrate that a selection associated with an item actually existed. Revealing unselected items assures players that the game is not a scam such as a "Shell Game" or "Three-Card-Monty" wherein there is actually no winning outcome. Furthermore, revealing unselected items serves to entice players by satisfying their curiosity in forgone possibilities. Thus, in multi-round gaming device described by Barrie in view of Feola and Kamille, wherein players select items hidden behind a plurality of symbols, it would have been obvious to an artisan at the time of the invention to reveal that all symbols having an assigned item indeed have and assigned item to demonstrate the game is not a scam and entice players into further attempts by revealing the forgone selections. The modification would enhance the gaming device by increasing players' feelings of fairness and excitement and thereby increase operator revenue.

**Claims 3, 4, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Feola and Kamille, as applied to claims 1 and 13 above, in further view of Demar et al., U.S. Patent 6,203,429 B1 (Mar. 20, 2001).**

Claim 3. The gaming device suggested by Barrie in view of Feola and Kamille describes all of the features of the claim except selecting items from a table. Demar teaches a gaming device in which items are randomly selected from a table. *See fig. 13(a,b), 14, 15.* By arranging the items in a table, the device provides a means to associate the item with another value. For example, figure 13(a) illustrates a table associating items with probabilities wherein each item has a different probability of occurring. In view of Demar, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device suggested by the combination of Barrie in view of Feola and Kamille, wherein different items are randomly associated with selections, to add the feature of selecting the items from a table. As taught by Demar, the modification would enhance by provides a means to associate the item with another value and thereby controlling probability of occurrence of each item.

Claim 4. Demar teaches a table of randomly selectable items wherein at least one item is adapted to be randomly selected more often than another item. *See fig. 13(a)(b), 14, 15.*

Claim 11: Demar teaches a table of randomly selectable prizes. *See fig. 15, 18.*

Claim 12: *Demar* teaches a table of randomly selectable prizes wherein at least one prize is adapted to be randomly selected more often than another. *See id.*

**Claims 14, 17 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Feola and Kamille, as applied to claims 1 and 13 above, in further view of Yoseloff et al., U.S. Patent 6,427,208 B2 (Oct. 29, 2002).**

Claims 14, 17 and 24: The gaming device suggested by Barrie in view of Feola and Kamille describes all the features of the instant claims except selecting the number of rounds the player has in the selection game. Yoseloff describes an analogous gaming device having multiple rounds in which the number of rounds the player has in the game is randomly determined prior to initiating the game. *See col. 4:36-50*. As a result, the length of the game is limited without being predictable by the player. In view of Yoseloff, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device suggested by the combination of Barrie in view of Kamille to add the feature of employing a table of numbers to designate the number of rounds the player has in the selection game. As taught by Yoseloff, randomly determining the number of rounds prior to initiating a game allows operators to limit the length of the game without being predictable by the player. As a result, operator's revenue will be preserved while enhancing the enjoyment of players.

Claim 25. Barrie teaches selecting a prize. *See fig. 2; p. 1:48-54, 2:6-22*.

Claim 26. Barrie teaches providing the prize to the player if the player chooses a symbol having an assigned item. *See id.*

Claim 27. Barrie teaches revealing that a symbol has an assigned item when the player selects a symbol having the assigned item. *See id.*



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Claim 28. The gaming device suggested by Barrie with Feola, Kamille and Yoseloff describes all the features of the instant claims except revealing that all symbols having an assigned item indeed have an assigned item. Regardless of the deficiency, the feature was known in the art at the time of the invention and would have been obvious to an artisan. It is notoriously well known in the art to reveal unselected selections from a set of hidden selections to demonstrate that a selection associated with an item actually existed. Revealing unselected items assures players that the game is not a scam such as a "Shell Game" or "Three-Card-Monty" wherein there is actually no winning outcome. Furthermore, revealing unselected items serves to entice players by satisfying their curiosity in forgone possibilities. Thus, in multi-round gaming device suggested by the combination of Barrie in view of Feola, Kamille and Yoseloff, wherein players attempt to select items hidden behind a plurality of symbols, it would have been obvious to an artisan at the time of the invention to reveal that all symbols having an assigned item indeed have and assigned item to demonstrate the game is not a scam and entice players into further attempts by revealing the forgone selections. The modification would enhance the gaming device by increasing players' feelings of fairness and excitement and thereby increase operator revenue.

**Claims 5-10 and 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barrie in view of Kamille and Demar, as applied to claim 3 above, in further view of Yoseloff.**

Claims 5, 15, 18 and 20. The combination of Barrie with Feola, Kamille and Demar describes all the features of the instant claims except employing the table of numbers to designate the number of rounds the player has in the selection game. Yoseloff describes an analogous gaming device having multiple rounds in which the number of rounds the player has in the game are randomly determined prior to initiating the game. *See col. 4:36-50*. As a result, the length of the game is limited without being predictable by the player. In view of Yoseloff, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device suggested by the combination of Barrie with

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Feola, Kamille and Demar, wherein different items are randomly selected from a table, to add the feature of employing a table of numbers to designate the number of rounds the player has in the selection game. As taught by Yoseloff, randomly determining the number of rounds prior to initiating a game allows operators to limit the length of the game without being predictable by the player. As a result, operator's revenue will be preserved while enhancing the enjoyment of players.

Claims 6 and 16. Demar teaches a table of randomly selectable items wherein at least one number is adapted to be randomly selected more often than another number. *See fig. 13(a,b), 14, 15.*

Claim 7. Demar teaches a plurality of tables of numbers. *See id.*

Claim 8. Demar teaches a table of randomly selectable items wherein at least one number is adapted to be randomly selected more often than another number. *See id.*

Claim 9. Demar additionally teaches the gaming device suggested by the combination of Barrie with Kamille and Demar and Yoseloff teaches all the features of the claim except having the a quantity of tables of numbers equaling the quantity of symbols in a round. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan. Demar describes a gaming device in values for some items are randomly selected from a table providing a means to associate the item with another value such as an occurrence rate in order to provide a variable outcome. *See fig. 13(a),(b), 14, 15.* In view of Demar, it would have been obvious to an artisan at the time of the invention to modify the gaming device suggested by the combination of Barrie with Kamille and Demar and Yoseloff, wherein outcomes are randomly distributed, to add the feature of having the a

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quantity of tables of numbers equaling the quantity of symbols in a round to provide a variable outcome for each item and thereby enhance players' enjoyment by making the game less predictable.

Claim 10. Demar teaches a table of randomly selectable items wherein at least one number is adapted to be randomly selected more often than another number. *See id.*

Claim 21. Barrie discloses changing the probability of selecting a winning symbol in each round. Hence, the gaming device suggested by the combination of Barrie with Kamille, Demar and Yoseloff, wherein the number of rounds and/or item probability is selected from a table, it would have been obvious to an artisan for the selected number of rounds each being associated with a different percentage of symbols having an assigned item.

#### **Allowable Subject Matter**

Claims 29-38 are allowed.

#### **Response to Arguments**

Applicant's arguments with respect to claims 1-18 and 20-28 have been considered but are moot in view of the new ground(s) of rejection.

#### **Prior Art, Not Relied On**

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure: US 5,085,436 discloses a gaming devices in which outcomes are randomly selected from randomly selected pools of outcomes.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

JOHN M. HOLTUNG, JR.  
PRIMARY EXAMINER